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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/655,656

09/05/2000

Mitsuhiro Nomi

F-6637

8113

7590

03/24/2003

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/655,656

Applicant(s)

NOMI ET AL.

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 1-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The abstract of the disclosure is objected to because of the following informalities:

The recited term "a microphones 4" (line 3 of the abstract) should be changed to "a microphone (4)"; and the numeral 48, line 6, should be parenthesized, i.e., (48).
Correction is required. See MPEP § 608.01(b).

2. Claims 1-11 are objected to because of the following informalities:

In claim 1, the recited term "an voice" (line 5) should be changed to "a voice"; the word "make" (line 1) should be changed to "makes"; and the word "and" should be inserted at the beginning of the last limitation.

Further, each limitation in the claim should be separated from the other by a semicolon (;). Appropriate correction is required.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Means for detecting motions of the player is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled

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by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The motion detection means (including acceleration sensor 31 and impact sensor 30), which is critical element of applicants' invention, has not been included in the claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: means for detecting motions of the player.

7. Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, the limitation of "a changing means for changing a degree of data processing by the data processing means..." is vague and indefinite since it is unclear exactly what type of degree is being changed.

In claim 9, the recited limitation of "wherein...background sounds" lacks antecedent basis.

In claim 10, the recited limitation of "wherein an instruction regarding a timing to input a voice to the voice input member of the voice converting means" lacks antecedent basis.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bolas et al. (5,513,129).

Bolas et al. teaches a game system in which a game player make motions in response to contents of instructions displayed on a display screen and generating predetermined sounds corresponding to the contents of instructions, the system comprising: a voice converting means having a voice input member for inputting voices and for converting the voices input through the voice input member into electrical signal data; a storage means for storing the electrical signal data obtained by the voice converting means together with predetermined sound-relating data corresponding to the contents of instructions; a sound generating means for generating voices from the corresponding electrical signal data based on the motions of the game player corresponding to the contents of instructions when the game player makes motions in response to the contents of instructions; the sound generating means includes a data processing means for processing the electrical signal data of the voices and generates voices corresponding to the electrical signal data processed by the data processing means; the data processing means has one, two, or more of a frequency modulating

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function; an amplitude modulating function; a function of changing the sound level of voices lying within at least part of frequency ranges divided at specified intervals; a function of thinning out sound lying within part of the frequency ranges; and a function of expanding and compressing at least part of sound waves with respect to a time axis; a signal generating means for generating a signal based on the motion made by the game player, wherein the sound generating means outputs a sound when the signal generating means generates a signal within a predetermined period; a second storage means in addition to the storage means, wherein a second electrical signal data stored in the second storage means is stored in the storage means, and the sound generating means generates a sound corresponding to the second electrical signal data; the data processing means processes the second electrical signal data, and the sound generating means generates a sound based on the processed second electrical signal data; a changing means for changing data processing by the data processing means; sounds relating to the second electrical signal data and background sound are stored in the second storage means, and the sound generating means outputs the background sounds without modification; the sound generating means generates a predetermined sound corresponding to the electrical signal data instead of generating a voice if no voice is input to the voice input member of the voice converting means. Note that, the limitation of an instruction regarding timing to input a voice to the voice input member of the voice converting means is displayed on the display screen at a specified moving speed (claim 10) is inherent from timing process or time track of Bolas et al.'s system. See Figures 1-11 and columns 1-12.


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

BN


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